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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,838	02/27/2002	Bradley F. Bowden	SP01-329	1759
22928	7590	04/13/2004	EXAMINER	
CORNING INCORPORATED			FIORILLA, CHRISTOPHER A	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	

1731

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/085,838	Applicant(s) BOWDEN ET AL.	
	Examiner Christopher A. Fiorilla	Art Unit 1731	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



Christopher A. Fiorilla
Primary Examiner
Art Unit: 1731

Continuation of 5. does NOT place the application in condition for allowance because:

With respect to the 112, first paragraph rejection applicants state that the specification includes all of the method steps required to produce a glass object having a substantially homogeneous index of refraction with substantially no striae. This statement is inconsistent with the specification in that the teaching of the specification include a titania dopant and thus there is no evidence that materials processed without titania would exhibit the same properties. Thus, it is submitted that undue experimentation, i.e. that associated with testing all other possible dopants, would be required to enable what is encompassed by the present claims.

With respect to the 103 rejection applicants argue the examiner has failed to make a prima facie case of obviousness, since he has failed to provide any citations to specific portions of the references. This argument is not persuasive. The office action is replete with citations to specific portions of the references, which are not required in order to provide a prima facie case of obviousness. MPEP 7.6.02(j) states that therelevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate. The examiner submits that the relevant teachings of the reference have been set forth.

Note, that applicant has not challenged the disclosure of the references but rather appears to merely argue that the examiner has not cite each and every description of the references with column and line number.

The examiner does agree that his reference to the Bernas et al. reference contains no specific recitations to the disclosure. Although there is no requirement to cite column and line numbers it is submitted that the teaching relied on in this reference is found in the abstract and elsewhere and thus is not buried within the body of the reference.

Further, the examiner has not relied on statements made in a previous rejection but rather has combined a reference used in the previous action (by another examiner) with a second reference. The use of the Hihara et al. reference and the repeated explanation of its disclosure does not constitute relying on statements in the previous rejection.

The statement that it would have been obvious to utilize specific parameters of a secondary reference in view of the generic disclosure of the primary reference does indeed provide proper motivation. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller 208 USPQ 871, 881; In re Sernaker 217 USPQ 1. It is maintained that one skilled in the art in viewing both references would have found it obvious to modify the primary reference with the specifics discussed in the secondary reference to perfect the process of the primary reference.